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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,915	06/26/2001	Yoichi Kobayashi	450100-03260	3853

20999 7590 04/29/2004

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
CAPRON, AARON J	
ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 04/29/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,915	KOBAYASHI ET AL.	
	Examiner	Art Unit	
	Aaron J. Capron	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 6-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 11.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

AJC

DETAILED ACTION

This is a response to the Request for Reconsideration received on February 17, 2004. Claims 1-4 and 6-12 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2004 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Referring to claim 1, the Applicants claim a printing apparatus for printing the printing data. Based upon the disclosure, the printing apparatus does not appear to be invented by the Applicants and is merely the video game player's own computer. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over English version of JPO Pub 09-000739 (hereafter "JPO '739") in view of Nogay et al. (U.S. Patent No. 5,993,088; hereafter "Nogay").

JPO '739 discloses a video game system comprising a video game apparatus, video game software program readout means, a non-volatile memory, a printer driver, printing control means, a printing apparatus, but does not specifically disclose the printer drive having a common engine module and dedicated engine modules. However, Nogay discloses a printer driver being made up of a common engine module for performing a process that is not dependent on the printer type (4:34-44). One would be motivated to combine the references in order to provide the ability to receive graphics from the applications and translates those into print jobs (1:26-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Nogay's common engine module into the game device of Pease in order provide the ability to receive graphics from the applications and translates those into a print jobs.

AJC (abstract + paragraph 9-15)

Claims 2-4 correspond in scope to a video game apparatus and method set forth for use of the video game apparatus listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 1-5, 7, 9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pease et al. (U.S. Patent No. 5,759,102; hereafter "Pease") in view of Nogay et al. (U.S. Patent No. 5,993,088; hereafter "Nogay").

Referring to claim 1, Pease discloses a video game system comprising a video game apparatus that includes video game software program readout means for reading out a video game software program from a video game program recording medium, having recorded thereon the video game software program, the video game software program being made up of a main portion of the video game software program, peripheral contents data and a peripheral driver; a non-volatile memory for storing the peripheral driver along with the information on game progress; peripheral driver updating means for updating the peripheral driver stored in the non-volatile memory by the new peripheral driver contained in the game software program read out by the video game software program readout means; and peripheral controlling means for reading out the peripheral driver stored in the non-volatile memory to a work memory and for converting the contents data read out from the video game program recording medium by the video game software program readout means; and a peripheral device (Figure 1 and 2:30-3:7), but does not disclose that a peripheral device is a printer However, it is notoriously well known in the art of computer systems that a printer can be added onto a computer system in order to print hardcopies of documents for personal or business records. Further, it is inherent feature that printers have a corresponding printer driver. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the printer as a peripheral device into Pease's invention in order to print hardcopy documents for records. Pease discloses a video game system, but does not disclose the video game system comprising the

printer driver is made up of a common engine module for performing a process which is not dependent on the printer type. However, Nogay discloses a printer driver being made up of a common engine module for performing a process that is not dependent on the printer type (4:34-44). One would be motivated to combine the references in order to provide the ability to receive graphics from the applications and translates those into print jobs (1:26-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Nogay's common engine module into the game device of Pease in order provide the ability to receive graphics from the applications and translates those into a print jobs.

Referring to claim 7, Pease in view of Nogay disclose a video game system. It is inherent that a player can print at any time from a computer, wherein the printout has printing content.

Claims 2-4, 9 and 11-12 correspond in scope to a video game apparatus and method set forth for use of the video game system listed in claims listed above and are encompassed by use as set forth in the rejection above.

Claims 6, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pease and Nogay as applied to claims 1-4 above, and further in view of Fawcett et al. (U.S. Patent No. 5,678,002; hereafter "Fawcett").

Referring to claims 6, 8 and 10, Pease in view of Nogay disclose a video game system, but do not disclose updating only outdated modules of the printer driver. However, Fawcett discloses the ability to provide patches and/or upgrades to features of a client's computer to update an older version with a newer version of software. One would be motivated to combine the references in order to provide the ability to upgrade a peripheral device without having to buy

a different printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Fawcett's ability to upgrade/patch existing software with the game machine of Pease and Nogay in order to provide the ability to upgrade a peripheral device without having to buy a different printer.

Response to Arguments

Applicants' arguments filed February 17, 2004 have been fully considered but they are not persuasive.

Applicants argue that Pease in view of Nogay fail to teach that the contents are printed in the course of the progress of the video game, the contents are converted into printing data to be printed. In response to applicant's arguments, the recitation "contents to be printed in the course of the progress of the video game" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In addition, the recitation "if there exist contents to be printed in the course of the progress of the game" is merely a conditional statement and the Examiner only has to satisfy one of the conditions. Further, the Applicants claim a system that does not distinguish from the prior art in terms of structure rather than function, see MPEP 2114. Therefore, the claimed language fails to preclude the invention of Pease in view of Nogay.

Applicant argues that Pease discloses "it may be necessary to suspend operation of the gaming terminal during downloading from the information source to the gaming terminal, and/or from the gaming terminal to the peripheral" (Paper #14, bottom of page 9). This statement also insinuates that it may not be necessary to suspend operations since the term may is used. In addition, the example that the Applicants use for the use for re-initializing/re-programming the peripheral device and is not the standard communication for operation between a game terminal and its peripheral device (for example, a coin acceptor for accepting coins-1:16-24). Therefore, the claimed language fails to preclude the invention of Pease in view of Nogay.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

JESSICA HARRISON
PRIMARY EXAMINER